

UNITED STATES PATENT AND TRADEMARK

OFFICE BEFORE THE PATENT TRIAL AND

APPEAL BOARD

FACEBOOK, INC and WHATSAPP INC.,

Petitioners

v.

UNILOC LUXEMBOURG S. A.

Patent Owner

Case IPR2018-00748

U.S. Patent 8,199,747

PATENT OWNER PRELIMINARY RESPONSE
PURSUANT TO 37 C.F.R. §42.107(a)

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List of Exhibits

Exhibit No.	Description
2001	Declaration of William C. Easttom II
2002	U.S. Pat. App. Pub. No. 2004/0128356 (" <i>Bernstein</i> ")
2003	Excerpts from <u>The American Heritage Dictionary</u> (Houghton Mifflin Co. 3rd Ed. 1992)
2004	Invalidity Contentions Submitted on December 16, 2016 in the underlying consolidated case of <i>Uniloc USA, Inc. v. Samsung Electronic America's, Inc.</i> , Case No. 2:16-cv-642

I. INTRODUCTION

Pursuant to 37 C.F.R. §42.107, Uniloc Luxembourg S.A. (the “Patent Owner”) submits this Patent Owner’s Preliminary Response to the Joinder Petition for *Inter Partes* Review (“Pet.” or “Petition”) of United States Patent No. 8,199,747 B2 (“the ‘747 patent” or “EX1001”) filed by Facebook, Inc. and WhatsApp Inc. (“Joinder Petitioners”) in IPR2018-00748.

The Petition challenges claims 2 and 12 of the ‘747 patent under 35 U.S.C. § 103 over Griffin (EX1005) in view of Zydney (EX1006). In view of the reasons presented herein, the Petition should be denied in its entirety as failing to prove obviousness. In this matter and in related matters, the Board has already considered arguments presented in the Petition and found them insufficient to prove unpatentability. Moreover, Petitioner should be estopped from arguing the opposite of what it argued in earlier proceedings.

II. RELATED MATTERS

In related matter IPR2017-01800, the Board noted in its original Institution Decision the importance of “maintain[ing] consistency across proceedings” and further noted “we are guided here by our analysis in the concurrently filed Decision on Institution concerning Case IPR2017-01799, concerning U.S. Patent No. 8,199,747, which is related to the ‘723 patent and includes” challenged claims that recite certain limitations analogous to those at issue here. IPR2017-01800, Paper 8 at 22. As will be shown, the Board’s findings in related matters IPR2017-01257 and IPR2017-02085 are also particularly instructive here.¹

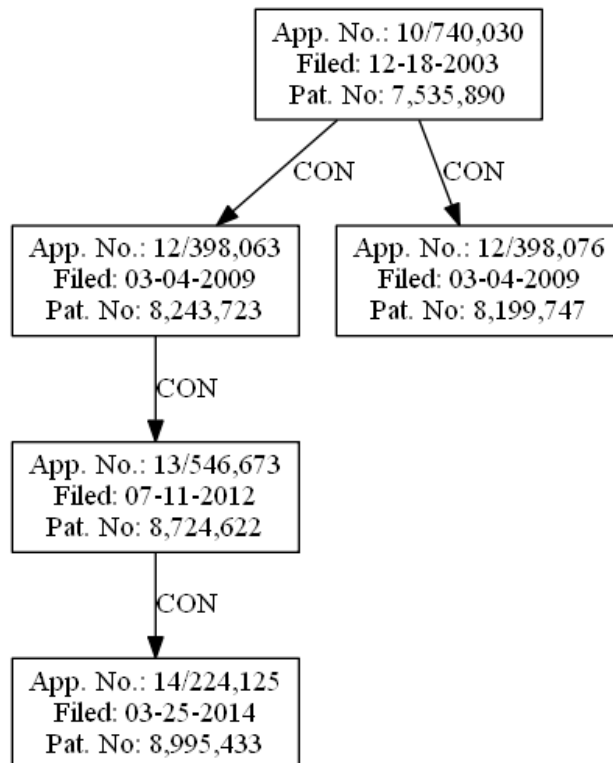
¹ The Petition appears to provide a comprehensive list of *inter partes* review proceedings concerning this family of patents.

III. THE '747 PATENT

A. Effective Filing Date of the '747 Patent

The '747 patent is titled "System and Method for Instant VoIP Messaging." The '747 patent issued June 12, 2012 from United States Patent Application No. 12/398,076, which is a Continuation of Application No. 10/740,030, filed on Dec. 18, 2003, now Pat. No. 7,535,890.

The '747 patent is in a family of patents including United States Patent Nos. 7,535,890 ("the '890 Patent"); 8,243,723 ("the '723 Patent"); 8,724,622 ("the '622 Patent"); and 8,995,433 ("the '433 Patent"). The diagram below shows how this family of patents is interrelated.



B. Overview of the '747 Patent

The '747 patent notes that conventional circuit-switched communications enabled traditional telephony yet had a variety of technical disadvantages that limited

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